

Appl. No. : 09/814,547
Filed : March 22, 2001

REMARKS

A. Introduction

The remarks herein are responsive to the Office Action dated April 5, 2007. Claims 1, 4-8, and 23-24 are pending in this application. Claims 1, and 4-8 stand rejected. Applicant has amended Claim 1, and added Claims 23-24 as new. Applicant respectfully submits that the claims are in condition for allowance. Applicant also thanks the Examiner for conducting an Examiner Interview with Applicant's counsel, William Bunker.

B. Amendments to the Claims

Claim 1 has been amended to now recite, among other things, "obtaining ownership in the intellectual asset if the venture receiving the investment fails to meet the minimum performance conditions; determining whether the intellectual asset has donation value based on predetermined considerations, wherein the intellectual asset will be determined to have donation value if it is determined that (i) there is a likely future market for the intellectual asset, (ii) there is a likelihood that other ventures can use the intellectual asset, or (iii) there is a likelihood that other ventures can obtain competitive protection by restricting access to the intellectual asset; determining that the intellectual asset has donation value and should be donated to a charitable organization; determining an appraised fair value for the intellectual asset based on predetermined factors, wherein the factors comprise at least one of cost of selling the intellectual asset within a reasonable period of time, sales of comparable intellectual assets, cost of reproduction of the intellectual asset, opinion appraisals of the intellectual asset, and any combination thereof."

Support for this amendment can be found at least in paragraph [0022] in the originally filed specification, and therefore, Applicant submits that no new matter has been entered by way of this amendment.

Claims 23-24 have been added as new. Support for this amendment can be found at least in paragraph [0022] in the originally filed specification, therefore, Applicant submits that no new matter has been entered by way of this amendment.

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C. Claim Rejections Under 35 U.S.C. § 112

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

Although Applicant disagrees with the foregoing rejection, Applicant has amended Claim 1 to facilitate prosecution of this case, and reserves the right to prosecute the previous version of Claim 1 at a later date. Amended Claim 1 now recites, among other things, “determining whether the intellectual asset has donation value based on predetermined considerations, wherein the intellectual asset will be determined to have donation value if it is determined that (i) there is a likely future market for the intellectual asset, (ii) there is a likelihood that other ventures can use the intellectual asset, or (iii) there is a likelihood that other ventures can obtain competitive protection by restricting access to the intellectual asset; determining that the intellectual asset has donation value and should be donated to a charitable organization.”

Accordingly, Applicant submits that amended Claim 1 more particularly points out and distinctly claims the invention pursuant to 35 U.S.C. § 112, second paragraph, and therefore Applicant respectfully requests withdrawal of the foregoing rejection.

D. Claim Rejections Under 35 U.S.C. § 103

1. Claims 1, 4-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,330,547 to Martin in view of Fairley’s article, “Dupont donates patents, gets tax write-off”, and in further view of Bowling’s article “Bank donates house to Habitat for Humanity”.

Applicant respectfully submits that Martin does not teach, suggest or disclose, among other things, “obtaining ownership in the intellectual asset if the venture receiving the investment fails to meet the minimum performance conditions; determining whether the intellectual asset has donation value based on predetermined considerations, wherein the intellectual asset will be determined to have donation value if it is determined that (i) there is a likely future market for the intellectual asset, (ii) there is a likelihood that other ventures can use the intellectual asset, or (iii) there is a likelihood that other ventures can obtain competitive protection by restricting access to the intellectual asset; determining that the intellectual asset has donation value and should be

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donated to a charitable organization; determining an appraised fair value for the intellectual asset based on predetermined factors, wherein the factors comprise at least one of cost of selling the intellectual asset within a reasonable period of time, sales of comparable intellectual assets, cost of reproduction of the intellectual asset, opinion appraisals of the intellectual asset, and any combination thereof,” as claimed in amended Claim 1.

Instead, Martin teaches a method and apparatus for deciding whether to make a *loan* using an intangible asset, such as intellectual property, as *collateral* and for making such a *loan* more attractive to a *lender*. See Abstract. Further, Martin teaches that a venture capital *investment* by a venture capitalist is distinct and separate from a *loan* made by a lender. Martin states that venture capital financing results in dilution of ownership of a company whereas debt financing does not result in a loss of ownership control. See col. 1, ln. 35-43.

As previously acknowledged by the Examiner, Martin does not disclose “transferring the intellectual property asset to a charitable organization.” See Office Action dated November 30, 2005 at 3-4. Further, Martin does not disclose, among other things, “determining whether the intellectual asset has donation value based on predetermined considerations, wherein the intellectual asset will be determined to have donation value if it is determined that (i) there is a likely future market for the intellectual asset, (ii) there is a likelihood that other ventures can use the intellectual asset, or (iii) there is a likelihood that other ventures can obtain competitive protection by restricting access to the intellectual asset; determining that the intellectual asset has donation value and should be donated to a charitable organization.”

Further, Fairley’s article teaches donating patents to a charitable organization for the benefit of a calculated tax deduction, and relief from patent maintenance fees. Fairley’s article does not disclose, among other things, “determining whether the intellectual asset has donation value based on predetermined considerations, wherein the intellectual asset will be determined to have donation value if it is determined that (i) there is a likely future market for the intellectual asset, (ii) there is a likelihood that other ventures can use the intellectual asset, or (iii) there is a likelihood that other ventures can obtain competitive protection by restricting access to the intellectual asset; determining that the intellectual asset has donation value and should be donated to a charitable organization,” as recited in amended Claim 1.

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Additionally, Bowling's article teaches a bank repossessing a property based on failure to repay a debt owned by the bank, and secured by the property, and the bank donating the property to a charitable organization. Bowling's article does not disclose, among other things, "determining whether the intellectual asset has donation value based on predetermined considerations, wherein the intellectual asset will be determined to have donation value if it is determined that (i) there is a likely future market for the intellectual asset, (ii) there is a likelihood that other ventures can use the intellectual asset, or (iii) there is a likelihood that other ventures can obtain competitive protection by restricting access to the intellectual asset; determining that the intellectual asset has donation value and should be donated to a charitable organization," as recited in amended Claim 1.

Therefore, Applicant submits that Martin in view of Fairley's article in further view of Bowling's article do not render Claim 1 obvious because the combination of the foregoing references do not produce the claimed invention, and thus, Applicant submits that amended Claim 1 is allowable for at least the reasons stated above. Claims 4-8 depend, directly or indirectly, on Claim 1, and therefore Applicant respectfully submits these claims are allowable for the same reasons as discussed above for Claim 1. Further, Claims 4-8 are allowable for the additional unique combination of features disclosed therein.

For the foregoing reasons, newly added Claims 23-24 are also allowable for at least the same reasons as set forth above for Claims 1, and 4-8.

E. Conclusion

Applicant respectfully submits that the claims are in condition for allowance. Furthermore, any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although changes to the claims have been made, no acquiescence or estoppel is or should be implied thereby; such amendments are made only to expedite prosecution of the present application and are without prejudice to the presentation or

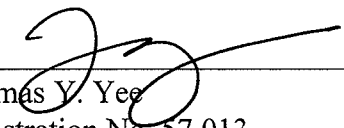
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assertion, in the future, of claims relating to the same or similar subject matter. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11 1410.

Respectfully submitted,

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